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No. 89-1931

In the Supreme Court of the United States

OCTOBER TERM, 1990

ROBERT T. HOWITT, PETITIONER

v.

UNITED STATES DEPARTMENT OF COMMERCE

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

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QUESTIONS PRESENTED

1. Whether the Federal Transfer Statute, 28 U.S.C. 1631, requires a federal court to entertain an untimely action when the plaintiff has failed promptly to file in the proper court after the action was dismissed for lack of jurisdiction by another federal court.

2. Whether the Equal Access to Justice Act, 5 U.S.C. 504(c)(2), indicates which court has jurisdiction over the appeal of the fee determination in this case.

3. Whether the court of appeals based its judgment on substantive grounds not properly before it.

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OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 1a-4a) is reported at 897 F.2d 583. The judgment of the district court (Pet. App. 7a-8a) is unreported.

JURISDICTION

The judgment of the court of appeals was entered on February 6, 1990. A petition for rehearing was denied on March 15, 1990 (Pet. App. 5a-6a). The petition for a writ of certiorari was filed as of June 4, 1990. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

STATEMENT

1. On September 8, 1982, petitioner applied for attorney's fees under the Equal Access to Justice Act (EAJA), 5 U.S.C. 504, to recompense him for time

spent obtaining a patent from the Patent and Trademark Office (PTO).[1] On June 16, 1983, the Deputy Assistant Commissioner for Patents issued a decision finding that the application process had not constituted an "adversary adjudication" within the meaning of the EAJA, and alternatively that the position of the government was substantially justified, rendering a fee award inappropriate. Pet. App. 14a; Gov't C.A. Br. 4. The following month, petitioner sought review before the Office of the General Counsel of the Department of Commerce.[2] Some four months later, petitioner filed a Supplemental Appeal to the General Counsel. *Ibid.*

2. In a decision and opinion by the General Counsel, dated July 2, 1986, the Department denied petitioner's application on the ground that fees are awarded under EAJA only to parties who prevail in an "adversary adjudication" with a government agency (if the position of the agency in the proceeding is not substantially justified and special circumstances do not make an award unjust). 5 U.S.C. 504 (a)(1). An "adversary adjudication" is defined in the EAJA, 5 U.S.C. 504(b)(1)(C), as "an adjudication under [5 U.S.C. 554] * * * in which the position of the United States is represented by counsel or

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[1] Petitioner's application for a patent was initially rejected by the PTO examiner; that rejection was affirmed by the PTO Board of Appeals. Petitioner's attempt to resolve the problem with his application (by filing a "notice of terminal disclaimer") was rejected by the PTO examiner as untimely. The PTO examiner in turn deemed petitioner's patent application abandoned. After petitioner sought review of that decision, the Deputy Assistant Commissioner for Patents withdrew the holding of abandonment. Pet. App. 12a-14a; Gov't C.A. Br. 2-4.

[2] Petitioner concurrently filed a request for reconsideration with the PTO, which the PTO denied. Pet. App. 14a.

otherwise." Section 554 of the Administrative Procedure Act in turn provides that "[t]his section applies * * * in every case of adjudication required by statute to be determined on the record after opportunity for an agency hearing." See Pet. App. 14a-15a.

The General Counsel noted that the only statute governing the processing of a patent application that alludes to any sort of hearing is 35 U.S.C. 7, which provides for PTO Board of Appeals review of adverse decisions of patent applications, with each appeal being "heard" by at least three members of the Board. Pet. App. 18a. However, the General Counsel observed, the statute does not require the hearing to be "on the record" and the legislative history does not indicate that there is to be a trial-type proceeding. "Consequently, there is no basis for concluding that the proceeding before the Board of Appeals is covered by section 554." Pet. App. 19a. The General Counsel finally noted that there is even less basis for claiming that proceedings before the PTO examiner and the Commissioner are Section 554 adjudications. Pet. App. 19a-21a.[3]

Petitioner appealed to the Court of Appeals for the Federal Circuit. On February 18, 1987, that court dismissed the case on the ground that it had no jurisdiction to review the Commerce Department's decision to deny attorney's fees; the court also denied petitioner's rehearing request. Pet. App. 9a-10a. Ten days later, petitioner requested the Federal Circuit to recall its mandate and asked for the first time

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[3] The General Counsel noted some doubt as to the timeliness of petitioner's original fee petition, but concluded that that question need not be reached in light of the denial of petitioner's claim on other grounds. Pet. App. 21a n.5.

that the case be transferred to the United States District Court for the District of Massachusetts. The Federal Circuit denied the request as reiterated in petitioner's supplemental petition two months later. On June 13, 1987, petitioner sought review in this Court; the Court denied his petition for certiorari on October 5, 1987. Pet. App. 3a.

3. Twenty-five days later, on October 30, 1987, petitioner filed a civil action in the United States District Court for the District of Massachusetts. The district court granted the government's motion for summary judgment on the ground that the PTO proceedings were not "adversary adjudications" under 5 U.S.C. 504(a)(1) and (b)(1)(C). The court further held that petitioner had failed to file a timely fee application and had failed timely to commence the action in that court. Pet. App. 7a-8a.

On appeal, the First Circuit affirmed. The court held that the 30-day time limit provided by the EAJA, 5 U.S.C. 504(c)(2), for appeal to a federal court from an agency's fee determination is jurisdictional and therefore cannot be waived. The court also rejected petitioner's argument that the jurisdictional defect was cured because, under the Federal Transfer Statute, 28 U.S.C. 1631, the Federal Circuit should have transferred his case to the proper court. The court noted that the Federal Circuit had not in fact transferred the case, and concluded that it lacked authority to review the other appellate court's decision not to transfer. In any case, the court noted, petitioner's argument that the PTO proceedings were "adversary" was so weak that "we could not second guess a Federal Circuit determination that transfer was not 'in the interest of justice,'" as required by Section 1631. Pet. App. 3a-4a.

ARGUMENT

The court of appeals' decision is correct and does not conflict with any decision of this Court or of any court of appeals. Further review is therefore not warranted.

1a. Petitioner argues (Pet. 6-9) that the district court should have taken "constructive transfer" of his case, on the ground that the Federal Transfer Statute, 28 U.S.C. 1631, *required* the Federal Circuit to transfer his case to the proper court, in this instance, the district court for the District of Massachusetts. However, the plain language of Section 1631 provides no authority for a court to transfer to itself a case that was timely filed only in another circuit. Rather, Section 1631 establishes that:

> Whenever * * * an appeal, including a petition for review of administrative action, is noticed for or filed with * * * a [federal] court and *that court* finds that there is a want of jurisdiction, the court shall, if it is in the interest of justice, transfer such action or appeal to any other such court in which the action or appeal could have been brought at the time it was filed or noticed * * *.

28 U.S.C. 1631 (emphasis added). In this case, the statute gave the Federal Circuit the power to transfer the case, if it had chosen to do so. It vested no such power in the district court—as prospective transferee—to accomplish by itself the same result when petitioner filed an appeal there more than fifteen months after his petition for fees was rejected by the General Counsel. And it certainly gave the district court no authority, under the euphemism of "constructive transfer," to engage in collateral review of the Federal Circuit's decision denying trans-

fer—a matter that became res judicata upon this Court's denial of the petition for certiorari to review the judgment of the Federal Circuit in October 1987.

In any event, the Federal Transfer Statute does not dictate a transfer in this case. Actions are to be transferred only if it is "in the interest of justice" to do so. 28 U.S.C. 1631. Justice would not have been served by the transfer of petitioner's fee application. As the courts below noted, the fee application was itself untimely (Pet. App. 8a) and lacked substantial merit (Pet. App. 4a, 8a).

b. The cases cited by petitioner (Pet. 8) are not to the contrary. In *Kolek* v. *Engen*, 869 F.2d 1281 (9th Cir. 1989), a litigant timely but mistakenly filed in the district court, when he should have filed in the court of appeals for the same circuit. On appeal from the district court's dismissal for lack of jurisdiction, the court of appeals held that it could "deem" the case transferred to it, given the mandatory nature of a transfer under Section 1631 and the gratuity of remanding to the district court for the reconsideration of the Section 1631 issue. 869 F.2d at 1284. The court in *Kolek* was following a previous Ninth Circuit case, *McCauley* v. *McCauley*, 814 F.2d 1350 (1987), which involved the same situation—a timely but mistaken appeal to a district court when jurisdiction properly rested with the court of appeals for the same circuit.[4] By contrast, here the district court in which petitioner ultimately sought to file lacked jurisdiction because the appeal was untimely

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[4] In similar circumstances, the District of Columbia Circuit did not cure the district court's failure to effect a transfer, because the appeal from the district court's dismissal of the case was itself untimely filed. *Center for Nuclear Responsibility, Inc.* v. *United States Nuclear Regulatory Commission*, 781 F.2d 935 (1986) (discussed at Pet. 8-9).

filed in that court and the court had no authority to review the Federal Circuit's decision or to order the Federal Circuit to transfer the case.

2. Next (Pet. 10-11), petitioner tries to excuse his untimely filings by suggesting a distinction between "the court with jurisdiction over the underlying dispute (the PT[O] proceeding)" and the court with jurisdiction over "the particular decision from which appeal is being taken (the DOC EAJA proceeding)" (Pet. 10).

Petitioner has already litigated—and lost—this jurisdictional contention before the Federal Circuit; and this Court denied certiorari. 818 F.2d 877 (Table), cert. denied, 484 U.S. 828 (1987). Under the applicable EAJA provision, 5 U.S.C. 504(c)(2), petitioner could have appealed the fees determination at issue here only in that court "having jurisdiction to review the merits of the underlying decision of the agency adversary adjudication." For the reasons set out in our previous brief in opposition, the "underlying decision" was the decision of the Deputy Assistant Commissioner to withdraw the holding of abandonment, and the court with jurisdiction to review the merits of the Deputy Assistant Commissioner's determination is the district court. See note 1, *supra;* 86-2004 Br. in Opp. 4-6 (filed August 12, 1987). Petitioner failed to file in the appropriate district court (the United States District Court for the District of Massachusetts) within 30 days. 5 U.S.C. 504(c)(2).

3. Finally, petitioner claims (Pet. 12) that the court of appeals impermissibly "reached a legal conclusion based on an issue ('adversary') [*sic*] which was intentionally not addressed by the administrative agency from which the appeal was taken." Apparently, petitioner contends that the General Coun-

sel's ruling was not based on a determination of whether the patent application proceedings were "adversary adjudication[s]" (5 U.S.C. 504(b)(1)(C)) for which fees could be awarded. Rather, in petitioner's view, the General Counsel based its ruling on the conclusion that "the patent statute does not require that patents be issued on the record with opportunity for a hearing." *Ibid.*

Petitioner fails to recognize that the General Counsel determined whether patent application proceedings were "on the record with opportunity for a hearing" in order to determine whether they constitute "adversary adjudication[s]." See Pet. App. 14a-19a. The court of appeals thus broke no new ground in noting that petitioner's arguments on this issue were unlikely ever to prevail.

In any case, the court of appeals in fact rested its judgment on the determination that it "lack[ed] the legal power to hear [petitioner's] appeal." Pet. App. 3a. It therefore properly affirmed the district court's dismissal of the case.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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